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MAILED

MAY 06 2010

OFFICE OF PETITIONS

In re Patent No. 7,504,437	:	
KOYAMA et al.	:	DECISION ON REQUEST FOR
Issue Date: March 17, 2009	:	RECONSIDERATION OF PATENT
Application No. 10/629,108	:	TERM ADJUSTMENT and
Filed: July 28, 2003	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No. 03338CIP/HG	:	CERTIFICATE OF CORRECTION

This is a decision on the RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION filed September 1, 2009, which is being treated as a renewed petition under 37 CFR 1.705(d). Patentees request that the patent term adjustment for the above-identified patent be corrected to one hundred forty-six days (146) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one hundred forty-six days (146) days.

On March 17, 2009, the above-identified application matured into U.S. Patent No. 7,504,437 with a revised patent term adjustment of fifty-eight (58) days. On May 8, 2009, patentees filed a request for reconsideration of patent term adjustment under 37 CFR 1.705(d) within two (2) months of the date the patent issued. On August 3, 2009, the Office mailed a decision granting the request for reconsideration to the extent that the patent term adjustment indicated on the patent was corrected by issuance of a certificate of correction showing a revised patent term adjustment of eighty-one (81) days. On September 1, 2009, patentees timely filed the present renewed petition within one month of the decision on the request for reconsideration of patent term adjustment mailed August 3, 2009.

Patentees dispute the reduction of sixty-five (65) days under 37 CFR 1.704(c)(10) for the filing of the "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" on January 12, 2009. Specifically, patentees argue:

The statements made by the Examiner in the December 31, 2008 USPTO COMMUNICATION were not set forth in the December 9, 2009 NOTICE.

[] In order to set the record "straight" and reply to the Examiner's misstatements of USPTO practice and the law, patentees were thus compelled to file a paper in reply to the December 31, 2008 USPTO COMMUNICATION. Patentees thus filed on January 12, 2009 a LETTER RE: USPTO COMMUNICATION DATED DECEMBER 31, 2008 (hereinafter referred to as the "January 12, 2009 LETTER"). It was the filing of the January 12, 2009 LETTER that resulted in an erroneous reduction of 65 days of patent term adjustment, the reversal of which is being requested herein.

The January 12, 2009 LETTER was patentees' first opportunity to reply to the Examiner's erroneous statements in the December 31, 2008 USPTO COMMUNICATION.

As discussed hereinabove, the December 31, 2008 USPTO COMMUNICATION referred to copies of Office Actions in copending family member applications that were submitted in patentees' IDS filed on October 24, 2008. In the January 12, 2009 LETTER, it was asserted that the

October 24, [2008] IDS was a proper Information Disclosure Statement in that it presented material information with respect to patentability, i.e., copies of Office Actions in copending family member applications. The submission of copies of Office Actions in copending related applications was held to be an appropriate procedure in McKesson Information Solutions, Inc. v. Bridge Medical Inc., 82 USPQ 2d 1865, 1885 (Fed. Cir. 2007).

Petition, 09/01/09, pp. 5-6.

The Office has reconsidered patentees' argument and finds it persuasive. The record confirms that patentees filed a "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" on January 12, 2009, after the mailing of the Notice of Allowance. Nonetheless, under the circumstances specific to this case, the filing of the "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" should not be considered "a failure to engage in reasonable efforts" to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10). The record reveals that filing the "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" on January 12, 2009, was patentees' first opportunity to address the matter. Accordingly, the reduction of sixty-five (65) days is not warranted and will be removed.

In view thereof, the patent term adjustment indicated on the patent should be **one hundred forty-six (146) days** (289 days of Office delay - 143 days of applicant delay).

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one hundred forty-six (146) days**.

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Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,504,437 B2

DATED : Mar. 17, 2009

INVENTOR(S) : Koyama et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 58 days

Delete the phrase "by 58 days" and insert – by 146 days--

Day : Wednesday

Date: 5/5/2010

Time: 14:27:18



PALM INTRANET

PTA Calculations for Application: 10/629108			
Application Filing Date:	07/28/2003	PTO Delay (PTO):	289
Issue Date of Patent:	03/17/2009	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	118
Post-Issue Petitions:	0	Total PTA (days):	146
PTO Delay Adjustment:	-25		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
157	05/05/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	65		
152	08/03/2009	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ISSUE			
151	07/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	23		
147	03/17/2009	PATENT ISSUE DATE USED IN PTA CALCULATION			
146	02/16/2009	EXPORT TO FINAL DATA CAPTURE			
145	02/13/2009	DISPATCH TO FDC			
144	02/11/2009	WORKFLOW - QUERY REQUEST - FINISH			
143	02/04/2009	ISSUE FEE PAYMENT VERIFIED			
142	02/04/2009	ISSUE FEE PAYMENT RECEIVED			
140	02/03/2009	MAIL-RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
139	02/03/2009	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
139	02/03/2009	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
138	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		30	
138	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO			
137	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		42	
137	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO			
136	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		41	
136	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO			
135	01/12/2009	MISCELLANEOUS INCOMING LETTER		65	134
134	12/31/2008	MAIL MISCELLANEOUS COMMUNICATION TO			

APPLICANT						
133	12/24/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT				
132	12/18/2008	PUBS CASE REMAND TO TC				
131	12/09/2008	PUBS CASE REMAND TO TC				
129	12/09/2008	MISCELLANEOUS INCOMING LETTER		23	134	
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127	12/09/2008	MAIL PUB NOTICE OF NON-COMPLIANT IDS				
126	12/09/2008	PUB NOTICE OF NON-COMPLIANT IDS				
125	11/25/2008	PETITION ENTERED				
124	11/21/2008	EXPORT TO INITIAL DATA CAPTURE				
123	11/18/2008	MAIL NOTICE OF ALLOWANCE				
122	11/18/2008	ISSUE REVISION COMPLETED				
121	11/18/2008	DOCUMENT VERIFICATION				
120	11/18/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED				
119	11/17/2008	NOTICE OF ALLOWABILITY				
118	11/14/2008	MAIL-PETITION DECISION - DISMISSED				
117	11/14/2008	PETITION DECISION - DISMISSED				
116	10/08/2008	REFERENCE CAPTURE ON IDS				
115	10/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED				
111	10/08/2008	DATE FORWARDED TO EXAMINER				
110	10/08/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)				
109	11/13/2008	DISPOSAL FOR A RCE / CPA / R129				
98	10/08/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED				
97.	10/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED				
96	10/14/2008	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE				
95	10/14/2008	RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE				
94	10/08/2008	WORKFLOW - REQUEST FOR RCE - BEGIN				
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92	05/08/2008	PETITION ENTERED				
91	06/23/2008	MAIL RESPONSE TO 312 AMENDMENT (PTO-271)				
89	06/19/2008	RESPONSE TO AMENDMENT UNDER RULE 312				

88	05/14/2008	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)			
87	05/20/2008	APPLICATION IS CONSIDERED READY FOR ISSUE			
86	05/15/2008	ISSUE FEE PAYMENT VERIFIED			
85	05/15/2008	ISSUE FEE PAYMENT RECEIVED			
84	01/24/2008	MISCELLANEOUS INCOMING LETTER			
83	02/25/2008	EXPORT TO INITIAL DATA CAPTURE			
82	02/20/2008	MAIL NOTICE OF ALLOWANCE	155		75
81	06/26/2007	ISSUE REVISION COMPLETED			
80	06/26/2007	DOCUMENT VERIFICATION			
79	06/26/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
78	06/25/2007	NOTICE OF ALLOWABILITY			
77	06/13/2007	MISCELLANEOUS INCOMING LETTER			
76	06/01/2007	DATE FORWARDED TO EXAMINER			
75	05/18/2007	RESPONSE AFTER NON-FINAL ACTION			
74	09/21/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
73	09/21/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
72	06/05/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
71	06/05/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
70	05/03/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
69	05/03/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
68	03/21/2007	MAIL NON-FINAL REJECTION	82		61
67	03/19/2007	NON-FINAL REJECTION			
66	09/28/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
65	08/29/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
64.7	09/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
64	09/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
63.7	08/29/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

63	08/29/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
62	02/26/2007	DATE FORWARDED TO EXAMINER			
61	08/29/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
60	02/26/2007	DISPOSAL FOR A RCE / CPA / R129			
59	02/26/2007	CASE DOCKETED TO EXAMINER IN GAU			
58	01/08/2007	FINISHED INITIAL DATA CAPTURE			
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56	06/22/2006	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
55	06/19/2006	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
54	06/02/2006	EXPORT TO INITIAL DATA CAPTURE			
53	05/30/2006	MAIL NOTICE OF ALLOWANCE			
52	05/25/2006	ISSUE REVISION COMPLETED			
51	05/25/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
50	05/25/2006	CASE DOCKETED TO EXAMINER IN GAU			
49	05/25/2006	NOTICE OF ALLOWABILITY			
48	05/11/2006	DATE FORWARDED TO EXAMINER			
47	05/03/2006	RESPONSE AFTER NON-FINAL ACTION		30	45
46	05/03/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
45	01/03/2006	MAIL NON-FINAL REJECTION			
44	11/16/2005	NON-FINAL REJECTION			
43	09/16/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
42	09/16/2005	REFERENCE CAPTURE ON IDS			
41.7	09/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
41	09/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
40	09/26/2005	DATE FORWARDED TO EXAMINER			
39	09/16/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
38	09/26/2005	DATE FORWARDED TO EXAMINER			
37	09/16/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
36	09/26/2005	DISPOSAL FOR A RCE / CPA / R129			

35	09/16/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
34	06/17/2005	MAIL FINAL REJECTION (PTOL - 326)			
33	06/16/2005	FINAL REJECTION			
32	05/26/2005	DATE FORWARDED TO EXAMINER			
31	05/17/2005	RESPONSE AFTER NON-FINAL ACTION			
30	04/25/2005	CORRESPONDENCE ADDRESS CHANGE			
29	02/22/2005	MAIL NON-FINAL REJECTION			
28	02/18/2005	NON-FINAL REJECTION			
27	12/20/2004	REFERENCE CAPTURE ON IDS			
26.7	12/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED	0	24	
26	12/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	01/15/2005	DATE FORWARDED TO EXAMINER			
24	12/20/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
23	12/20/2004	WORKFLOW INCOMING AMENDMENT IFW			
22	11/19/2004	MAIL RESTRICTION REQUIREMENT	52	-1	
21	11/18/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
20	04/29/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
19	04/29/2004	CASE DOCKETED TO EXAMINER IN GAU			
18	10/23/2003	PRELIMINARY AMENDMENT			
17	04/25/2004	CASE DOCKETED TO EXAMINER IN GAU			
16	03/02/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
15	10/23/2003	PRELIMINARY AMENDMENT			
14.7	10/22/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	10/22/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	12/12/2003	APPLICATION RETURN FROM OIPE			
12	12/12/2003	APPLICATION RETURN TO OIPE			
11	12/12/2003	APPLICATION DISPATCHED FROM OIPE			
10	12/12/2003	APPLICATION IS NOW COMPLETE			
9	10/22/2003	ADDITIONAL APPLICATION FILING FEES			
8	07/28/2003	CLAIM PRELIMINARY AMENDMENT			
7	10/22/2003	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			

6	10/20/2003	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED		
4	10/11/2003	CASE CLASSIFIED BY OIPE		
3	10/11/2003	CLEARED BY OIPE CSR		
2	09/19/2003	IFW SCAN & PACR AUTO SECURITY REVIEW		
1	07/28/2003	INITIAL EXAM TEAM NN		

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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